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10/529,954	02/28/2006	Mark Patrick	4623-051017	5535
28289 7590 08/18/2008 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219				
EXAMINER				
SPAHN, GAY				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,954

Applicant(s)

PATRICK, MARK

Examiner

Gay Ann Spahn

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006 and 30 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of SPECIES X (i.e., Fig. 6 with reinforcing component 19 of Fig. 3 and composite slab) in the reply filed on 30 June 2008 is acknowledged.

Claim 9 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected SPECIES, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 30 JUNE 2008.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 15 June 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

The drawings are objected to because:

(1) Fig. 1, "A" should be changed to —II—in accordance with 37 CFR 1.84(h)(3);
and

(2) Figs. 1, 2, and 5, the arrows at the end of the lead lines leading from reference numerals "5" and "7" should be deleted as failing to comply with 37 CFR 1.84(r)(1-3).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. *It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.* (Emphasis added).

The abstract of the disclosure is objected to because:

(1) the first sentence of the Abstract uses a phrase that can be implied (i.e., "is disclosed") and should be rewritten.

Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Since many examiners use the title of the invention for searching purposes, the examiner suggests that Applicants amend the title of the invention to one that is clearly indicative of the patentable feature of the invention. However, should Applicants choose not to amend the title of the invention, the examiner will amend the title of the invention at the time of allowance, if any (pursuant to the Manual of Patent Examining Procedure (MPEP) § 606.01, wherein it states that "[i]f a satisfactory title is not supplied by the applicant, the examiner may, at the time of allowance, change the title by examiner's amendment.").

Claim Objections

Claim 11 is objected to because of the following informalities:

(1) claim 10, line 3, the word "lines" should be changed to --line--; and

(2) Claim 11, lines 1-2, the recitation of "the additional reinforcing elements is cranked handlebar-shaped" is grammatically incorrect.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 9, the recitation of "a said embedded shear connector or connectors" is vague, indefinite, and confusing as lacking antecedent basis because it is not clear if this is referring back (i.e., "said") to the "at least one shear connector" introduced in line 6 or is introducing an additional shear connector (i.e., "a") and the examiner suggests amending to --said at least one shear connector" for clear antecedent basis.

Claim 1, lines 8-9, the recitation of "a reinforcing component embedded in at least one concrete rib that includes a said embedded shear connector or connectors" is vague, indefinite, and confusing as not being clear. First, is it the reinforcing component

that includes the embedded shear connector or is it the at least one concrete rib that includes the embedded shear connector. Second, if the reinforcing component includes the embedded shear connector, then Fig. 3 is incorrect because it shows reference numeral "19" which represents the "reinforcing component" as only being made of line wires "41" and cross wires "45", not shear connectors.

Claim 2, line 3, the recitation of "ie in the longitudinal direction of the beam" is vague, indefinite, and confusing as not being clear. Applicant must claim his invention using definite terms and cannot say "i.e." or "in other words" in the claim.

Claim 4, lines 2-3, the recitation of "in a situation in which the composite beam includes a composite slab rather than a solid slab" is vague, indefinite, and confusing because it is not clear whether Applicant is reciting that the composite beam includes a composite slab or not.

Claim 4, line 4, the recitation of "a plurality of metal pans being separated by metal ribs" is vague, indefinite, and confusing because a plurality of metal pans is two metal pans and two metal pans are separated by only one metal rib, not plural metal ribs.

Claim 5, line 2, the recitation of "adjacent metal ribs" is vague, indefinite, and confusing as lacking antecedent basis because it is not clear if this is referring back to the metal ribs introduced in claim 4.

Claim 6, lines 2-3, the recitation of "the height of the adjacent metal ribs" is vague, indefinite, and confusing as not being clear because the ribs themselves are flat and have no height.

Claim 8, line 3, the recitation of "line wires and cross wires" is vague, indefinite, and confusing as lacking antecedent basis because it is not clear if this is referring back to the line wires and cross wires introduced in claim 1.

Claim 12, lines 3-4, the recitation of "the solid slab on the composite slab" is vague, indefinite, and confusing as not being clear because the solid slab as been introduced as being in the alternative to the composite slab so it is not understood how the solid slab could be one the composite slab.

Claim 13, line 2, the recitation of "a plurality of shear connectors" is vague, indefinite, and confusing as lacking antecedent basis because it is not known if the plurality of shear connectors are in addition to the at least one shear connector introduced in claim 1 or if the at least one shear connector of claim 1 is one of the plurality of shear connectors.

Claim 14, line 2, the recitation of "a plurality of shear connectors" is vague, indefinite, and confusing as lacking antecedent basis because it is not known if the plurality of shear connectors are in addition to the at least one shear connector introduced in claim 1 or if the at least one shear connector of claim 1 is one of the plurality of shear connectors.

Claim 15, line 2, the recitation of "a plurality of shear connectors" is vague, indefinite, and confusing as lacking antecedent basis because it is not known if the plurality of shear connectors are in addition to the at least one shear connector introduced in claim 1 or if the at least one shear connector of claim 1 is one of the plurality of shear connectors.

Claim 17, line 9, the recitation of "a said embedded shear connector or connectors" is vague, indefinite, and confusing as lacking antecedent basis because it is not clear if this is referring back (i.e., "said") to the "at least one shear connector" introduced in line 6 or is introducing an additional shear connector (i.e., "a") and the examiner suggests amending to --said at least one shear connector" for clear antecedent basis.

Claim 17, lines 8-9, the recitation of "a reinforcing component embedded in at least one concrete rib that includes a said embedded shear connector or connectors" is vague, indefinite, and confusing as not being clear. First, is it the reinforcing component that includes the embedded shear connector or is it the at least one concrete rib that includes the embedded shear connector. Second, if the reinforcing component includes the embedded shear connector, then Fig. 3 is incorrect because it shows reference numeral "19" which represents the "reinforcing component" as only being made of line wires "41" and cross wires "45", not shear connectors.

Claim 17, line 12, the recitation of "ie in the longitudinal direction of the beam" is vague, indefinite, and confusing as not being clear. Applicant must claim his invention using definite terms and cannot say "i.e." or "in other words" in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by PATRICK (Australian Patent Application Publication No. AU 200169998 A1).

As to claim 1, PATRICK discloses a composite beam which includes:

a beam (5);

a solid slab or a composite slab (29 above 11, 11 is a composite slab because of reinforcing bars therein) positioned on and supported by the beam (5), the solid slab and the composite slab (29) including a slab section (portion of concrete 29 above line incorporating 11, 11) and a plurality of concrete ribs (portion of concrete 29 below line incorporating 11, 11) extending from the slab section (portion of concrete 29 above line incorporating 11, 11);

at least one shear connector (15) positioned in at least one of the concrete ribs (portion of concrete 29 below line incorporating 11, 11) and connecting the solid slab or the composite slab (29) to the beam (5); and

a reinforcing component (any of Fig. 3, Fig. 5, and Fig. 7) embedded in at least one concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13) that includes a said embedded shear connector or connectors (15), the reinforcing component (any of Fig. 3, Fig. 5, and Fig. 7) being in the form of a mesh that includes line wires (41 or 61) and cross wires (47 or 63) that are connected together at the intersections of the wires.

As to claim 2, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that the mesh (41/47 or 61/63) is positioned so that the line wires (41 or 61) extend in the longitudinal direction of the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13), i.e., in the longitudinal direction of the beam (5).

As to claim 3, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also disclose that the mesh (41/47 or 61/63) is positioned in the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13) between 25% and 75% (portions of the mesh 41/47 or 61/63 are within this range so as to meet the claim language) of the height of the concrete rib (portion of concrete 29 below line incorporating 11, 11).

As to claim 4, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that in a situation in which the composite beam includes a composite slab (29 above 11, 11 is a composite slab because of reinforcing bars therein) rather than a solid slab, the composite slab (29 above 11, 11 is a composite slab because of reinforcing bars therein) includes profiled metal sheeting (7) having a plurality of metal pans (13, 13) separated by metal ribs (11, 11) and concrete cast (29) on the profiled sheeting (7), whereby the metal pans (13, 13) and the metal ribs (11, 11) define an outer surface of the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13).

As to claim 5, PATRICK discloses the composite beam of claim 4 as discussed above, and PATRICK also discloses that the mesh (41/47 or 61/63) is positioned in the

concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13) below the level of tops of adjacent metal ribs (11, 11) of the profiled sheeting (7).

As to claim 6, PATRICK discloses the composite beam of claim 5 as discussed above, and PATRICK also discloses that the mesh (41/47 or 61/63) is positioned in the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13) between 25% and 75% (portions of the mesh 41/47 or 61/63 are within this range so as to meet the claim language) of the height of the adjacent metal ribs (11, 11).

As to claim 7, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that the mesh (41/47 or 61/63) extends across the width of the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13) at the position of the mesh (41/47 or 61/63) in the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13).

As to claim 8, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that the reinforcing component (any of Fig. 3, Fig. 5, and Fig. 7) is a flat sheet of welded wire mesh (bottom 61/63 in Fig. 7) that includes a rectangular array of parallel line wires (61, 61) and cross wires (63, 63) welded together at the intersections of the wires (61, 61, 63, 63).

As to claim 10, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that the reinforcing component (any of Fig. 3, Fig. 5, and Fig. 7) further includes a plurality of additional reinforcing elements (upper 61, 61

and upper 63, 63 and unnumbered horizontal rebars connecting upper 61, 61 and lower 61, 61) that extend transverse to (upper 63, 63 and unnumbered horizontal rebars connecting upper 61, 61 and lower 61, 61 are transverse to line wires 61, 61) the lines wires (lower 61, 61) of the mesh (lower 61/63) and have one or more than one section out of the plane of the mesh (lower 61, 63).

As to claim 13, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that there are a plurality of shear connectors (15, 15) in the form of headed studs.

As to claim 17, PATRICK discloses a composite beam which includes:

a beam (5);

a solid slab or a composite slab (29 above 11, 11 is a composite slab because of reinforcing bars embedded therein) positioned on and supported by the beam (5), the solid slab and the composite slab (29) including a slab section (portion of concrete 29 above line through 11, 11) and a plurality of concrete ribs (portion of concrete 29 below line through 11, 11) extending from the slab section (portion of concrete 29 above line through 11, 11);

at least one shear connector (15) positioned in at least one of the concrete ribs (portion of concrete 29 below line through 11, 11) and connecting the solid slab or the composite slab (29) to the beam (5); and

a reinforcing component (any of Fig. 3, Fig. 5, and Fig. 7) embedded in at least one concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13) that includes a said embedded shear connector or connectors (15),

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the reinforcing component (any of Fig. 3, Fig. 5, and Fig. 7) being in the form of a mesh that includes line wires (41 or 61) and cross wires (47 or 63) that are connected together at the intersections of the wires, the mesh (41/47 or 61/63) being positioned so that the line wires extend in the longitudinal direction of the concrete rib (portion of concrete 29 below line through 11, 11), i.e., in the longitudinal direction of the beam (5), and the mesh (41/47 or 61/63) being positioned in the concrete rib (portion of concrete 29 below line through 11, 11) between 25% and 75% (portions of the mesh 41/47 or 61/63 are within this range so as to meet the claim language) of the height of the concrete rib (portion of concrete 29 below line through 11, 11)..

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over PATRICK (Australian Patent Application Publication No. AU 200169998 A1) in view of BONACCI ET AL. (U.S. Patent Application Publication No. 2004/0182027) or RAPP (U.S. Patent No. 4,811,770).

As to claim 11, PATRICK discloses the composite beam of claim 10 as discussed above.

PATRICK fails to explicitly disclose that the additional reinforcing elements is [sic – are] cranked handlebar-shaped.

Either BONACCI ET AL. or RAPP discloses that it is well known in the art to use crank handlebar-shaped reinforcing elements (23/24 in BONACCI ET AL. or tie rods 8 in RAPP).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composite beam of PATRICK by including additional reinforcing in the form of crank handlebar-shaped rebars as taught by either BONACCI ET AL. or RAPP in order to be able to tie reinforcing bars in the mesh to reinforcing bars in the composite slab.

As to claim 12, PATRICK in view of either BONNACCI ET AL. or RAPP discloses the composite beam of claim 10 as discussed above, and the resulting composite beam from the combination of PATRICK in view of either BONNACCI ET AL. or RAPP also discloses that the section or sections of each additional reinforcing element (23/24 of BONNACCI ET AL. or tie rods 8 in RAPP) that is out of the plane of the mesh (lower 61/63 of PATRICK) extends from the concrete rib (portion of concrete 29 below line through adjacent ribs 11, 11 and within metal pan 13 in PATRICK) into the slab section of the solid slab on [sic – or] the composite slab (29 above 11, 11 in PATRICK).

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over PATRICK (Australian Patent Application Publication No. AU 200169998 A1).

As to claim 14, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that there is a plurality of shear connectors (15, 15).

PATRICK fails to explicitly disclose a minimum spacing between the shear connectors along the length of the beam of at least 5 times the diameter of the shear connectors.

However, it is well settled that changes in size/proportion do not constitute a patentable difference. See *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), wherein the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composite beam of PATRICK by making a minimum spacing between the shear connectors along the length of the beam be at least 5 times the diameter of the shear connectors in order to provide sufficient shear connectors to prevent shear failure between the concrete ribs and the composite slab and because changes in size/proportion do not constitute a patentable difference.

As to claim 15, PATRICK discloses the composite beam of claim 1 as discussed above, and PATRICK also discloses that there is a plurality of shear connectors (15, 15).

PATRICK fails to explicitly disclose that the spacing between the shear connectors along the length of the beam is no more than 7.5 times the height of the shear connectors above the top of the concrete ribs.

However, it is well settled that changes in size/proportion do not constitute a patentable difference. See *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), wherein the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composite beam of PATRICK by making the spacing between the shear connectors along the length of the beam be no more than 7.5 times the height of the shear connectors above the top of the concrete ribs in order to provide a sufficient length of the shear connectors above the concrete ribs to prevent shear failure between the concrete ribs and the composite slab and because changes in size/proportion do not constitute a patentable difference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)272-7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gay Ann Spahn/
Gay Ann Spahn, Primary Examiner
August 14, 2008